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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,705	03/17/2000	Robert A. Luciano	732.083	3145

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EXAMINER
MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/527,705	LUCIANO, ROBERT A.	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-79* is/are pending in the application.

4a) Of the above claim(s) *58-64* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-57 and 65-79* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 March 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Claims 1-57 and 65-79 in Paper No. 4 is acknowledged.

Drawings

The drawings are objected to because FIG 2 misspells the word OOPS as OPPS and the word LOSE and LOOSE. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

The disclosure is objected to because of the following informalities: On page 12, line 5 the spinning wheel game is referred to as reference 12. It is reference 14. On page 18 STARTING is improperly spelled as staring. Appropriate correction is required.

The abstract of the disclosure is objected to because of the usage of the self-evident clause "The specification discloses". Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 5-8, 14, and 41-44, objected to because of the following informalities: It is preferable to state "said" and name the modifier instead of "the" because as currently worded it is not immediately clear as to what Applicant is claiming. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 9, 37, 65, and 68 and those dependent therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, one of ordinary skill would not understand the metes and bounds of that which is claimed in lines 13-19 and furthermore the interchanging of "activator" and "actuator" in defining the same component wherein the component is named in claims 1, 9, 37, 65, and 68 prohibits one of ordinary skill in the art from understanding the metes and bounds of these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-10, 15-16, 19, 21-22, 24, 26, 28-29, 31, 33-34, 36, 50, 52, 54, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff (US Patent No. 6,224,483) in view of Stanley (GB 2,320,206).

Mayeroff et al. disclose a gaming apparatus to play games of chance wherein the apparatus consists of a first housing portion housing a spinning reel first game of chance (FIG 2, reference 110) with an outcome display, an award display (FIG 1, reference 40), a first game actuator (FIG 2, reference 138) that is activated for play by the game player. Furthermore, the apparatus consists of a second housing portion housing a spinning wheel second game of chance (FIG 2, reference 150) with a range of outcomes that can alter the award to the game player (Abstract) by providing an additional award. The second game of chance is mounted proximate and adjacent in an integral game frame with the first game of chance whereby the player can observe both games from one location (FIG 1) and the second game of chance has an outcome display and an actuator (FIG 2, reference 140) that is activated by the primary gaming unit has randomly selected one of a plurality of indicia sets (Column 5, lines 23-26).

Stanley teaches of an amusement apparatus that has a first type of game that upon a predetermined completion will initialize a second type of game and success on the second game will lead to a further game on the first game (Abstract). In the disclosed apparatus, the second game of chance can lead to an alteration of the result of the first game of chance (page 5, lines 21-23) by obtaining a predetermined alteration outcome as a result of the game, such as rotating the reels (FIG 4, reference 10, NUDGES) and changing the first game outcome in the first game outcome display and providing a chance-improving outcome as the reels can then be moved to a winning combination. Further another alteration of the first game outcome provided for by the second game would be to spin until a win is achieved (FIG 4, reference 10, SPIN A WIN).

Applicant notes that an ongoing goal of the gaming industry is to develop slot type machines that are more exciting to play and thus more likely to be played and generate revenue. Stanley teaches of an amusement device where play is more exciting given the fact that the bonus round can alter the base round and there are such bonus awards as spin until a win and nudge. With these additional features, the bonus game would become much more exciting to the user as there is higher anticipation of a positive result from the bonus. By incorporating an apparatus that provides the user with a higher anticipation of an award and greater excitement, the lure of the machine is greatly increased and the goal of the gaming industry is met as the slot machine is more exciting to play and thus more likely to be played and generate revenues. For these reasons, it would have been obvious to one skilled in the art at the time of invention to incorporate the bonus round teachings of Stanley into the apparatus of Mayeroff to create a game of chance where the bonus round is more exciting and enticing to the user.

Claims 11-14, 17-18, 20, 23, 25, 27, 30, 32, 35, 51, 53, 55, 57, and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff (US Patent No. 6,224,483) in view of Stanley (GB 2,320,206) further in view of Crawford (US Patent No. 5,997,401).

What Mayeroff and Stanley disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Crawford teaches of a slot machine with a symbol save feature which allows a player to save in memory (and retrieve for later use in determining a winning combination) one or more symbols from one or more previous games and use those symbols in a current or future game to obtain a winning combination (Abstract, lines 3-5) and alter the likelihood of obtaining an award. This device is located on the gaming machine (FIG 5, reference 54).

As is well known in the art, when a user perceives a greater chance of winning on a gaming machine, the user is more likely to participate in play of that machine. By incorporating the symbol save feature of Crawford into the apparatus of Mayeroff in view of Stanley, the user would get even more enjoyment out of the bonus round as it would be possible to store the bonus features for use at a later time. Therefore, it would have been obvious to one skilled in the art at the time of invention to incorporate the teachings of Crawford into the apparatus of Mayeroff in view of Stanley to create a bank in which the user could store a symbol obtained in the bonus round for use in the primary round at a later time in order to give the user a feeling of better control over their own fate in the game, thus giving a perception of a greater likelihood of award winnings.

In response to the method claims 65-67, these claims are directed to claiming the "end-use", i.e. to provide a method of chance using the disclosed invention, the function or operation

of the claimed apparatus within the instant application. It is well understood by those of ordinary skill in the art that the "end-use" of a well-known product is not patentable where there has not been a showing of criticality for that "end-use" being claimed as a method. Likewise, it is well understood by those of ordinary skill in the art that: 1) claiming how a well known device found within the prior art would be operated by one of ordinary skill in the art or 2) claiming how that same device would function when one of ordinary skill in the art would construct such a well known device, is not patentable because it is deemed obvious within the purview of knowledge of those of ordinary skill within the art. At this point, within the instant application, the Applicant has not demonstrated by evidence any criticality for the "end-use" of the disclosed apparatus. Instead, the Applicant demonstrates and claims how to operate the disclosed invention and how said invention functions when a patron would use the disclosed invention and there appears no criticality for the functionality or operability of the disclosed device; criticality appears just for the device *per se*, and not its modes of operation or usage. Therefore, absent a showing of criticality for the "end-use" to the invention, one of ordinary skill in the art at the time of the invention was made would find it obvious to use the disclosed invention found in the prior art of Mayeroff in view of Stanley further in view of Crawford which meets the claimed limitations of the apparatus in the end manner claimed within these claims. Likewise, how a well known device found within the prior art functions and how one of ordinary skill in the art would operate it or permit a user to operate it is obvious to one of ordinary skill in the art absent a showing of criticality to the contrary.

Claims 37-40, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff (US Patent No. 6,224,483) in view of Stanley (GB 2,320,206) further in view of Kaku et al. (JP 05285252).

What Mayeroff and Stanley disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Kaku et al. teaches of increasing user enjoyment by increasing the number of combinations that would produce a winning result (page 3, lines 11-14). To address this issue, the disclosed invention includes three donut-shaped disks that are in a concentric relation (page 4, lines 1-2) and have patterns of numbers, letters, or pictures (page 4, line 25). The disks are rotated independently and are stopped separately (page 5, line 1-2), thus they spin sequentially. Moreover, the number of disks can be made two 9page 8, line 15).

By replacing the wheel device of the bonus round with the concentric wheel device taught by Kaku et al., the user would enjoy the bonus round more as the number of winning combinations would appear to be or actually be increased. This would provide more excitement to the user than a solo rotating wheel as there would be more than one rotating factor involved in determining the result of the bonus round. Therefore, it would have been obvious to one skilled in the art at the time of invention to incorporate a different design choice as a means for presenting the bonus round. By incorporing the design choice taught by Kaku et al., the user would experience a greater sense of enjoyment from the bonus round as it would be more exciting when a plurality of spinning wheels are involved and a greater sense of a winning possibility is experienced.

Claims 41-44, 47, 48-49, and 68-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff (US Patent No. 6,224,483) in view of Stanley (GB 2,320,206) further in view of Kaku et al. (JP 05285252) further in view of Crawford (US Patent No. 5,997,401).

For the above discussed reasons, it would have been obvious to one skilled in the art to further incorporate the combined teachings of Crawford and Kaku et al. into the apparatus disclosed by Mayeroff in view of Stanley in order to even further user excitement by providing a small amount of user control by allowing symbols to be saved while at the same time incorporating a more exciting bonus round where greater winning combination is perceived.

In response to the method claims 68-79, these claims are directed to claiming the "end-use", i.e. to provide a method of chance using the disclosed invention, the function or operation of the claimed apparatus within the instant application. It is well understood by those of ordinary skill in the art that the "end-use" of a well-known product is not patentable where there has not been a showing of criticality for that "end-use" being claimed as a method. Likewise, it is well understood by those of ordinary skill in the art that: 1) claiming how a well known device found within the prior art would be operated by one of ordinary skill in the art or 2) claiming how that same device would function when one of ordinary skill in the art would construct such a well known device, is not patentable because it is deemed obvious within the purview of knowledge of those of ordinary skill within the art. At this point, within the instant application, the Applicant has not demonstrated by evidence any criticality for the "end-use" of the disclosed apparatus. Instead, the Applicant demonstrates and claims how to operate the disclosed invention and how said invention functions when a patron would use the disclosed invention and there

appears no criticality for the functionality or operability of the disclosed device; criticality appears just for the device *per se*, and not its modes of operation or usage. Therefore, absent a showing of criticality for the "end-use" to the invention, one of ordinary skill in the art at the time of the invention was made would find it obvious to use the disclosed invention found in the prior art of Mayeroff in view of Stanley further in view of Crawford further in view of Kaku et al. which meets the claimed limitations of the apparatus in the end manner claimed within these claims. Likewise, how a well known device found within the prior art functions and how one of ordinary skill in the art would operate it or permit a user to operate it is obvious to one of ordinary skill in the art absent a showing of criticality to the contrary.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent No. 6,168,520: Gaming apparatus with bonus feature activated when predetermined condition is met where bonus feature includes three wheels.

US Patent No. 6,089,977: Gaming apparatus with bonus feature that changes the result of the original game by having a wild card roam the symbols and replacing some of the symbols thus changing the appearance on the display.

JP 6-91034: Teaching of using concentric circular plates as the mechanics of a slot machine to increase interest.

US Patent No. 6,059,289: Method for playing a bonus game in a secondary machine adjacent to a first machine wherein a bonus qualifying signal is sent from the primary machine to

the secondary machine to indicate a start of play of a bonus game when a bonus qualifying event occurs. The reels of the bonus game include value symbols, null symbols, and stop symbols. Values won from bonus game are accumulated into an accrued winning value.

US Patent No. 5,342,049: A reel slot machine with a pinball machine where player manipulates a ball about a playing surface and the travel of the ball can result in additional spins of one or more of the reels of the slot machine so that other winning opportunities can be created.

US Patent No. 6,186,894: Player can achieve a combination of symbols on the main reel game that awards the player with the secondary reel game event, where the spins on the secondary event can be either winning or losing spins.

GB 2 201 821 A: Coin-operated gaming machine which offers a prospect of a win, including a plurality of rotatable members which are provided with symbols to determine a win or a loss and are associated with display windows and a microcomputer fitted with a random generator for controlling the entire course of the game. Furthermore, a second game of a rotatable disc with different wining panels is provided.

US Patent No. 6,142,873: Rotatable wheel game where a gaming device and method is provided hat provides a paler with an opportunity of enhanced output based on display of first predetermined value on a first display which subsequently activates a second display with an enhanced winning scheme.

JP 405131044 A: Rotary disk provided as a bonus condition based upon a hit mark of cards displayed on a monitor screen.

US Patent No. 5,848,932: Rotatable wheel provided as a discernible additional payout indicator when primary reels of slot machine stop on certain predetermined indicia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Friday (7:30AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Martin-Wallace can be reached on (703)-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

C. Marks

C. Marks
September 26, 2002

MICHAEL O'NEILL
PRIMARY EXAMINER